

Neifeld Docket No: PIP-69B-KATZ

Application/Patent No: 09/828,122

USPTO CONFIRMATION NO: 5972

File/Issue Date: 4/9/2001

Inventor/Title: Katz/Paid Promotion Architecture

Examiner/ArtUnit: Rhetta/3622

ENTITY STATUS: Large

Priority claims: None

ENTITY STATUS: Large

Priority claims and PCT Intl data: US 60/256,324 filed December 19, 2000

**37 CFR 1.7©) FILING RECEIPT AND TRANSMITTAL LETTER WITH
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37 CFR 41.41 REPLY BRIEF

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Date: 8/20/2009

/RichardNeifeld#35,299/

Printed: January 25, 2010 (5:52pm)

RICHARD NEIFELD, REG. NO. 35,299

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ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

37 CFR 41.41 REPLY BRIEF

Sir:

In response to the examiner's answer dated 11/27/2009, consider this reply brief.

UPDATE TO RELATED APPEALS

As noted in the appeal brief "In docket number PIP-69A-KATZ; Application No. 09/776,714, filed February 6, 2001, an appeal brief was filed February 6, 2009. The appeal has not been docketed by the BPAI." Note that since then, on 11/30/2009, the examiner reopened prosecution in 09/776,714 by issuing a new non final office action.

REJECTION, PHRASED IN THE ANSWER AS OBJECTION, TO CLAIM 27

The answer reiterates at page 1 an objection to claim 27. Since this objection is represented in an answer to an appeal brief, the undersigned treats this as a ground of rejection. Since the BPAI has jurisdiction over grounds of rejection, it is authorized to consider whether the rejection of claim 27, although referred to in the answer as an objection, should be reversed.

The examiner objects to the form of claim 27, implying that it is indefinite, because it is ambiguous, which is an issue the BPAI is authorized to review. The examiner's argument is that product claim 27 could be a "method of making a product", which means the examiner deems it ambiguous whether it is a method claim, or a product claim.

Claim 27 is not ambiguous. Claim 27 is product claim. Claim 27 recites "A computer readable medium". Claim 27 is not a dependent claim because it does not depend from claim 1. Instead, it incorporates by reference the method steps of claim 1 to define the "program instructions" defined in the computer readable medium. It is an incorporation claim. Hence, claim 27 is not ambiguous. Therefore, the rejection of claim 27 as not indefinite.

This situation is distinct from that in Pfizer, Inc. v. Ranbaxy Laboratories Limited, _____ F.3d, 1284, 79 USPQ2d 1583 (Fed. Cir. 8/2/2006) in that claim 27 does not recite inconsistent

limitations (claim 6 claiming a salt depending via claim 2 from claim 1 defining an acid.). Claim 27's reference to claim 1's method steps to define "program instructions" recorded on a media is not inconsistent. This situation is distinct from that in Ex parte David, appeal No. 89-0461 (BPAI 4/9/1990) because the applicant's claim does not mix process and structure limitations in the same claim and therefore does not embrace different 35 USC 101 statutory classes. Claim 27 is not within the purview of MPEP 2173.05(p) because claim 27 does not claim both apparatus and method of using the apparatus.

In sum, claim 27 is not ambiguous and therefore its rejection phrased in the answer as an object, should be reversed.

35 USC 112, 1ST PARAGRAPH

The answer continues to rely upon the conclusion that the specification fails to disclose "how the promotions are redeemed". Answer numbered page 5 line 6. That reliance is misplaced because claim 1 does not recite "redeeming". Instead, it recites "deducting from a charge for said purchase transaction a value of promotion associated with said second promotion and a value of promotion associated with said first promotion". Support for that recitation is discussed in the appeal brief. Accordingly, the rejection should be reversed because it assumes lack of support for something claim 1 does not recite. The same reasoning applies to claim 23.

35 USC 112, 2ND PARAGRAPH

The basis for these rejections were addressed in the appeal brief.

EXAMINER RESPONSE TO ARGUMENT

Answer page 10 lines 12-23 contain text which is not grammatically correct and not comprehensible.

At answer paragraph spanning pages 10 and 11, the examiner asserts that the specification does not disclose the "only if..." claim recitation (claim 1's "only if said first consumer first product category purchase determination indicates no prior purchase by said first consumer of either an item of said first product or of an item in said first product category, storing, with said at least one processor, in a database in a computer memory in association with said first consumer identification information, said first promotion"). In response, note that the paragraph at page 18 lines 6-19 discusses situations where the product or class is one that the "consumer has not purchased ... before." Clearly, what that means in connection with the database of consumer purchases discussed elsewhere, is that the data is queried and determines that the consumer has not purchased the product or category before. Hence, the appellant believes that the examiner is incorrect on this point.

At answer page 11 first full paragraph, the examiner argues that purchase history information is ambiguous as to whether it includes identification products previously purchased. In response, the appellant disagrees. Claim 1 recites "wherein said product purchase history information indicates identification information for consumers associated with purchase of items of products by said consumers, such that each identification information for each consumer is associated with identification of previous purchase of items of products by that consumer." It is simply unreasonable to allege that "product purchase history information" does not indicate that it includes product history.

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